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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/103,846 06/24/98 WOYCHIK

R CASE-03330

HM22/0315

EXAMINER

MARTIN, J

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

03/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

FILE

Office Action Summary

Application No.
09/103,846

Applicant(s)
Woychik et al.

Examiner
Jill D. Martin

Group Art Unit
1632



☒ Responsive to communication(s) filed on Oct 10, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8, 10-22, 24-28, 30, 31, and 33-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8, 10-22, 24-28, 30, 31, and 33-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicants After Final Amendment filed October 10, 2000 (Paper No. 11) has been entered. Claims 9, 23, 29, and 32 have been canceled, claims 1, 3, 15, 17, 31, and 34 have been amended, and claims 35 and 36 have been added. Claims 1-8, 10-22, 24-28, 30, 31, and 33-36 are pending and are under current examination.

Oath/Declaration

It is acknowledged that Applicants have submitted a Certificate under 37 CFR 3.73(b) filed October 10, 2000 (Paper No. 10), however, it is maintained that Applicants' Petition for correction of the inventorship filed April 24, 2000 is deficient because:

An oath or declaration by each actual inventor or inventors listing the entire inventive entity has not been submitted.

NEW GROUND(S) OF REJECTION:

The indicated allowability of claims 1-8, 10-22, 24-28, 30, 31, and 33-36 as per Paper Nos. 12 & 13 (see also draft Examiner's Amendment attached to Paper No. 13, wherein the examiner's amendments reflect only amendments with regard to clarity) is withdrawn in view of the newly discovered reference(s), US Patent Nos. 6,015,670 & 6,033,861. Rejections based on the newly cited reference(s) follow.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-8, 10-22, 24-28, 30, 31, and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by either Schafer et al. (US Patent 6,033,861) or Goodfellow (US Patent 6,015,670).

The claimed invention is directed to a method of chemical mutagenesis of embryonic cells, in particular for the use of the embryonic cells to produce the corresponding animal.

Schafer et al. teach methods for inducing mutations in embryonic cells (sperm cells, ova, embryonic stem cells) by chemical mutagenesis for introduction of a frequency of mutations in a gene of interest in the genome of an animal. See column 6, lines 55-68. Schafer et al. teach that chemical mutagens are classifiable by chemical properties, e.g., alkylating agents, cross-linking agents, etc., and list numerous representative mutagens. In particular, Schafer et al. teach that ENU, MNU, procarbazine hydrochloride, and chlorambucil are especially useful for mutagenesis of male germ cells. See column 10, lines 18-46, and Table I. See also claims 5 & 6.

Goodfellow teach methods of chemical mutagenesis of embryonic stem cells for identifying a mutation in a gene of interest in an organism. Goodfellow teaches that chemical mutagens are classifiable by chemical properties, e.g., alkylating agents, cross-linking agents, etc.,

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and list numerous representative mutagens. In particular, Goodfellow teaches that ENU, MNU, procarbazine hydrochloride, and chlorambucil are especially useful for mutagenesis of male germ cells. See column 14, lines 28-67, and Table I. See also claims 1-4.

As such, the methods of either Schafer et al. or Goodfellow meet all of the limitations of the claimed methods.

Accordingly, either Schafer et al. or Goodfellow anticipate the claimed invention.

Conclusion

No claim is allowed.

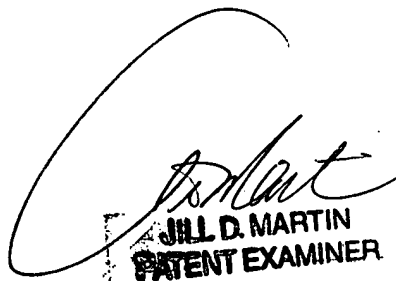
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Martin whose telephone number is (703)305-2147.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Karen Hauda, can be reached at (703)305-6608.

Any inquiry of a general nature or relating to the status of this application should be directed to the Kay Pinkney whose telephone number is (703)305-3553.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.



JILL D. MARTIN
PATENT EXAMINER

Jill D. Martin
Patent Examiner
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